

REMARKS

Introduction

The filing of this Amendment and concurrent RCE, including the claim amendments made herein are the result of a telephonic discussion between the undersigned attorney and Examiner Jeff Hoekstra of the USPTO on 2011-04-14. This Amendment will constitute the undersigned attorney's confirmation of the substance of that interview according to the Rules.

The undersigned acknowledges with appreciation, the time and effort Examiner Hoekstra spent in preparing to discuss and discussing this application, reviewing its procedural history and suggesting the amendments made herein. As is noted above, the entire purpose for both the procedural maneuver (i.e. filing an RCE) and the amendments are to place this application in condition for an early Notice of Allowance.

Comment regarding "Notice of Re-opening Prosecution"

It is noted at paragraphs 1-3 of the Final Office Action the prosecution of this application has been reopened. It was noted by the prior examiner handling this application, Fangemonique Smith, per her Advisory Action dated 2010-10-21 at paragraph 13 that:

"Examiner submits arguments presented in Examiner Interview and response are persuasive and has agreed to withdraw the finality of the outstanding final office action dated 2010-08-05. Another office action is forthcoming."

Examiner Smith's 2010-10-21 Advisory Action followed the undersigned's 2010-10-11 submission entitled "Amendment and Response "After Final" Under 37 C.F.R. §1.116 and Confirmation of the Substance of the 10/6/2010 Telephonic Interview." In that submission (top of pg.7) the undersigned noted that Examiner Smith agreed Jafari et al. would be withdrawn as a §102 reference. In essence all of the rejections in that of the 2010-08-05 Final Rejection were effectively withdrawn because all of the rejections in that 2010-08-05 Final Rejection relied in whole or in part upon the withdrawn Jafari et al. reference. In other words, Applicant's 2010-10-11 submission, perhaps incorrectly, indicated that it was submitted under 37 C.F.R. §1.116. Applicants should have referenced 37 C.F.R. §1.111 and referred to it as a Supplemental Amendment rather than Amendment "After Final". Cutting to the conclusion, the amendments made in the 2010-10-11 document were not submitted under Rule 116 and were, in fact, voluntary, meaning perforce, the Office should have entered those indicated amendments.

Nevertheless due to the extremely short period of time in which the present Final Rejection was prepared,¹ the conclusion was reached during the aforementioned 2011-04-14 interview that the operant set of claims were those submitted on 2010-05-27. It is, in fact, that set of claims which have been amended and are concurrently filed herein with the RCE.

Drawings

Objection is taken to the drawings in paragraph 7 of the Final Office Action for the absence of support of the subject matter of claims 105 and 106. Claim 105 is not believed to be dependent upon any illustrative structure. The undersigned and Examiner Hoekstra discussed this rejection in the 2011-04-14 telephonic interview and agreed that this objection would be withdrawn if Applicants cancelled claim 106. In fact, Applicants have cancelled claim 106 so it is believed that this drawing objection has been overcome.

Claim rejections under 35 U.S.C. §112

At paragraph numbered 9-16 of the Final Office Action various §112 rejections are raised. It was Examiner Smith's version of these objections that the undersigned was responding to in his submission dated 2010-10-11. Those same amendments are included in the attached claim amendments noted above. It is believed, therefore, that all of the rejections in paragraphs 9-16 under §112 have been overcome.

Claim Rejections – 35 U.S.C. §102(b)

Claims 87-102 and 104-107 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 3,674,014 ("Tillander"). That rejection is respectfully traversed. The ancient Tillander reference (issued on Independence Day in 1972) has a title of "Magnetically Guidable Catheter-tip and Method." The catheter of Tillander is described in column 1 line 9 as follows:

"Recently developed medical procedures require the placement of a catheter or fine tube into selected vessels or organs within the body. For example, in the practice of arteriography of the distal vessels it is necessary to inject a roentgenographic substance into the selected area before taking the X-ray. In addition, certain therapeutic techniques require the injection of certain medicines by way of the vascular system directly into the selected organ."

Several observations may be made about Tillander. The first is that Tillander says nothing at all

¹ Examiner Smith did not prepare another Office Action as indicated in her 2010-10-21 Advisory Action leaving this application in limbo until Examiner Hoekstra completed her commitment under very short notice.

about guidewires. Thinking perhaps that the ancient catheter-tip language of Tillander was an antecedent to the modern guidewire, the undersigned ran a search through the earliest guidewire patents he was able to find. As early as July 1, 1969, viz. U.S. 3,452,740 W. F. Muller referred to a device which is antecedent to today's guidewires as a "spring guide". Further, in U.S. patents 3,906,938 and 3,789,841, filed at approximately the same timeframe as Tillander, the description of the devices were either "wire guide" or "guide wire". Thus, Tillander clearly, in 1970's, was not referring to any structure which has subsequently become known as a "guide wire" when he referred to his own invention as a "catheter".

Substantively, the device of Tillander is not in any way usable to address total or partial vascular occlusions as is the utility of the present device. In fact, FIG. 2 of Tillander shows a device with a hollow central lumen and basically a tip having a hole which leads to that lumen. This is, of course reasonable, in that the catheter of Tillander et al. is intended to be used to inject roentgenographic substances into a venous structure. It is not in any sense intended to be used to guide a subsequent catheter, as is the modern guidewire, nor it is in any sense intended to cross an occlusion as is the specific present guidewire's utility. Thus, it should come as no surprise that Tillander, in the undersigned's view, does not anticipate the claims of the present invention.

The undersigned and Examiner Hoekstra discussed ways in which the claims of the present application could be amended to clearly and unambiguously distinguish Tillander and, it is believed by the undersigned, any other prior art presently in the record. Specifically, Examiner Hoekstra urged the undersigned to define more carefully in claim 87 the structure referred to as the "terminal member." That is precisely what is intended in the amendments to claim 87, those amendments being made to expedite prosecution of this application.

In summary, and in confirmation of the 2011-04-14 telephonic discussion, the leading edge portion of the terminal member has been more carefully defined to require it to be "radiused", having a "chisel edge" and having converging first and second and third and fourth surfaces which produce and define the radiused chisel edge. Basis for the amendments made to claim 87 are found in the present disclosure at page 5 line 7, ("chisel edge"), page 7 line 1 ("radiused") and page 17 line 11 wherein the radiused nature of leading portion is discussed in yet greater detail. Without limiting the interpretation of claim 87, the FIGS. most closely related to the claim 87, as amended, are 7 and 12. Applicants specifically reserve the right to file claims of differing scope to cover other embodiments of this invention.

No new matter has been introduced by utilization of the indicated aspects of the specification to amend the present claims.

All dependent claims in this application depend directly or indirectly from claim 87. Thus, with the above-amendments to claim 87 to yet even more clearly distinguish Tillander it is believed that the various rejections of the dependent claims found in paragraphs 21-39 of the Final Office Action have all been overcome.

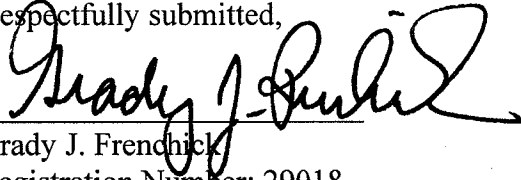
Claim Rejections 35 U.S.C. §103

Claims 40-46 of the Final Office Action various obviousness rejections have been raised with regards to claims 103 by the combination of Tillander in view of U.S. 5,135,483 ("Wagner et al."). That rejection is respectfully traversed.

In the first instance, as is noted above, Tillander does not in any sense of the medical word disclose a guidewire. Wagner et al. also does not disclose a guidewire. The title of their invention "Atherectomy Device with a Removable Drive System" again is not a guidewire. As is noted in Wagner et al. the field of the invention relates to "intravascular catheters, particularly catheters having a rotating tip, useful in removing in occlusions [sic] from a vessel, such as an artery or vein." It does not seem plausible that two non-guidewire disclosures could somehow be combined to support an obviousness rejection for what is clearly, and which the claims require it to be, a guidewire. Withdrawal of the obviousness rejection of claim 103 is respectfully requested.

Dated: May 16, 2011

Respectfully submitted,


Grady J. Frenchick
Registration Number: 29018

P.O. Address

Whyte Hirschboeck Dudek S.C.
33 East Main Street, Suite 300
Madison, Wisconsin 53703-3300
Tel. No. 608-255-4440
Customer No. 56080